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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Steven M. Belz et al.

**SYSTEM INCLUDING A DIGITAL
CAMERA AND A DOCKING UNIT FOR
COUPLING TO THE INTERNET**

Serial No. US 10/017,809

Filed November 30, 2001

Group Art Unit: 2612
Examiner: Chriss S. Yoder, III

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October 22, 2004
Date

Commissioner for Patents
P.O. Box 1450
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Sir:

SUPPLEMENTAL APPEAL BRIEF

This Supplemental Appeal Brief is submitted in response to the Office Action dated July 22, 2004 in the above-referenced application, in which the Examiner reopened prosecution in response to the previously-filed Appeal Brief.

Applicants have submitted concurrently herewith a response to the Office Action, requesting reinstatement of the appeal.

Applicants hereby appeal the rejection of claims 1-7 and 9-15 of the above-identified application.

REAL PARTY IN INTEREST

The present application is assigned of record to Eastman Kodak Company. The assignee Eastman Kodak Company is the real party in interest.

RELATED APPEALS AND INTERFERENCES

There are no known related appeals and interferences.

STATUS OF CLAIMS

The present application was filed on November 30, 2001, with claims 1-8. In an amendment filed on October 17, 2003, Applicants canceled claim 8, and added new claims 9-15. Claims 1-7 and 9-15 are currently pending in the present application, and stand rejected under 35 U.S.C. §103(a). Claims 1-7 and 9-15 are appealed.

STATUS OF AMENDMENTS

No amendment has been filed subsequent to final rejection.

SUMMARY OF INVENTION

An illustrative embodiment of a system in accordance with the invention is shown in FIG. 1, and described in the corresponding text at page 6, line 21, to page 7, line 3, of the specification. The system comprises a digital camera 300 having a docking interface 322 to facilitate connection with a docking unit 350. The docking unit 350 is configured to establish a connection with a network service provider 30, which may be an Internet service provider (ISP). The system further includes a content service provider 40, which communicates with the camera 300 via the network service provider 30. The content service provider 40 receives and stores digital image files uploaded from the digital camera 300, and stores and downloads digital image files and other information to the camera 300.

An example image capture and display process that may be implemented in the FIG. 1 system is illustrated in FIG. 2, and described in the corresponding text at page 15, line 24, to page 24, line 19, of the specification.

Generally, in this example process, the digital camera captures digital images at a high resolution, and such captured images are uploaded via the docking unit to a service provider. See steps 110-118 of FIG. 2. The digital camera also receives digital images from the service provider, via the docking unit, for viewing on

an image display of the camera. See steps 120-124 of FIG. 2. The digital images transferred from the service provider to the camera are at a lower resolution than the captured digital images transferred from the camera to the service provider.

The present invention in the illustrative embodiment provides a number of significant advantages relative to conventional techniques. For example, as indicated at page 4, lines 12-24, the invention provides a system in which the same digital camera used for capturing images, and displaying the captured images, may be easily and efficiently used for displaying images provided by others, for example, images which have been stored by a service provider and communicated by the service provider over a channel such as the Internet.

ISSUES PRESENTED FOR REVIEW

1. Whether claims 1, 3 and 11 are unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,167,469 (hereinafter “Safai”) in view of Japanese Publication No. 2000-232599 (hereinafter “Viktors”) and in further view of U.S. Patent No. 6,392,697 (hereinafter “Tanaka”).
2. Whether claim 2 is unpatentable under §103(a) over Safai, Viktors and Tanaka in view of U.S. Patent Application Publication No. 2001/0024236 (hereinafter “Sato”).
3. Whether claim 4 is unpatentable under §103(a) over Safai, Viktors and Tanaka in view of the Japan Electronic Industry Development Association Standard entitled “Design Rule for Camera File System,” Version 1.0 (hereinafter “Design Rule”).
4. Whether claims 5-7, 9, 10 and 12-15 are unpatentable under §103(a) over Safai in view of Sato.

GROUPING OF CLAIMS

With regard to Issue 1, claims 1 and 11 stand or fall together, and claim 3 stands or falls alone.

With regard to Issue 2, claim 2 stands or falls alone.

With regard to Issue 3, claim 4 stands or falls alone.

With regard to Issue 4, claims 5-7, 9 and 10 stand or fall together, and claims 12-15 stand or fall together.

ARGUMENT

Issue 1

Applicants initially note that a proper *prima facie* case of obviousness requires that the cited references when combined must teach or suggest all the claim limitations, and that there be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references or to modify the reference teachings. See Manual of Patent Examining Procedure (MPEP), Eighth Edition, August 2001, §706.02(j).

Applicants submit that the Examiner has failed to establish a proper *prima facie* case of obviousness in the §103(a) rejection of claims 1, 3 and 11, in that the Safai, Viktors and Tanaka references, even if assumed to be combinable, fail to teach or suggest all the claim limitations, and in that no cogent motivation has been identified for combining the references or modifying the reference teachings to reach the claimed invention.

Independent claim 1 is directed to a system including a digital camera and a docking unit that permits the digital camera to be coupled to a channel for communication with a service provider. The claim specifies that the digital camera includes a memory for storing captured digital images at a first image size and transferred digital images at a second image size that is smaller than the first image size. The captured digital images at the first image size are images captured by the digital camera, for transfer from the docking unit to the service provider over the established channel, while the transferred digital images at the second image size are transferred from the service provider to the docking unit over the established channel. Thus, the claim explicitly specifies that images transferred from a service provider to the camera via the docking unit have a smaller image size than captured images transferred from the camera to the service provider via the docking unit.

The Examiner argues that the above-noted limitations of claim 1 are obvious in view of the proposed combination of Safai, Viktors and Tanaka. However,

these references, even if assumed for purposes of argument to be combinable, fail to meet the limitations of claim 1.

Applicants note that there is apparently no teaching in any of the cited references regarding the above-noted limitation specifying that images transferred from a service provider to a camera via a docking unit have a smaller image size than captured images transferred from a camera to a service provider via the docking unit. The Examiner acknowledges, at page 3, last line, to page 4, line 2, of the Office Action that Safai fails to meet this limitation. Applicants note in this regard that Safai not only fails to disclose the limitation, but in fact teaches away from it by disclosing at column 15, lines 33-41, that there is no distinction in resolution between pictures uploaded from the camera or downloaded to the camera in their FIG. 6 image transport system.

The Examiner relies on the teachings in Tanaka, at column 5, lines 9-13, column 6, line 63, to column 7, line 1, and column 9, lines 48-49, as allegedly supplying the missing teachings. However, these portions of Tanaka generally teach to reduce the resolution of an image that is transmitted from a digital camera to a remote device, which may be another digital camera, based on the capabilities of the receiving device. This is apparent from, for example, column 5, lines 30-41. The present invention, by way of contrast, specifies that images transferred from a service provider to a camera via a docking unit have a smaller image size than captured images transferred from a camera to a service provider via the docking unit. There is no general teaching of this type in Tanaka. In fact, the relied-upon teachings include disclosure which teaches directly away from the claimed invention. For example, the column 5, lines 9-13, portion provides as follows:

The color still image signal generated by CCD Camera 10 and stored in memory 14 contains 240,000 pixels per frame; after reduction the displayed image contains 60,000 pixels per frame. The difference in the number of pixels makes it possible to more quickly transmit the image.

This substantial reduction in captured image resolution represents a direct teaching away from the claimed invention, in which captured digital images transferred from a digital camera to a service provider are transmitted at a higher image size than images transferred from the service provider to the digital camera.

Accordingly, the proposed combination fails to meet the claimed arrangement in which images transferred from a service provider to the camera via the docking unit have a smaller image size than captured images transferred from the camera to the service provider via the docking unit.

Inasmuch as independent claim 1 includes limitations not taught or suggested by the combined teachings of Safai, Viktors and Tanaka, the Examiner has failed to establish a *prima facie* case of obviousness.

Also, as indicated previously, the Examiner has failed to identify a cogent motivation for combining the references or modifying the reference teachings to reach the claimed invention.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination “must be based on objective evidence of record” and that “this precedent has been reinforced in myriad decisions, and cannot be dispensed with.” In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that “conclusory statements” by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved “on subjective belief and unknown authority.” Id. at 1343-1344. There has been no showing in the present §103(a) rejection of objective evidence of record that would motivate one skilled in the art to combine the Safai, Viktors and Tanaka references to produce the particular limitations in question. Instead, the proposed combination appears to be based on a piecemeal reconstruction of the claimed invention, with the benefit of hindsight, rather than on any objective evidence of motivation.

More particularly, the Examiner in the Office Action at page 4, section 3, indicates that it would be obvious to combine the references because Tanaka teaches that images can be transmitted “more quickly due to the reduced number of pixels.” This ignores the fact that the relied-upon portions of Tanaka teach to transmit

captured digital images from a digital camera at a low resolution, which is directly contrary to the claimed invention. Also, the statement of motivation fails to address the actual limitation in question, in that it fails to address why that particular limitation would be obvious when there is no teaching or suggestion in Tanaka regarding use of a first image size for transfer of captured images from a camera to a service provider, and a second, smaller image size for transfer of images from the service provider to the camera.

It therefore appears that the Examiner in formulating the §103(a) rejection of independent claim 1 has undertaken a piecemeal reconstruction of the claimed invention based upon impermissible hindsight, given the benefit of the disclosure provided by Applicants.

Furthermore, even if it is assumed that a proper *prima facie* case has been established, the above-noted teachings away, identified by Applicants, constitute substantial evidence of non-obviousness.

The §103(a) rejection of independent claim 1 is therefore believed to be improper, and should be withdrawn.

Dependent claims 3 and 11 are believed allowable for at least the reasons identified above with regard to independent claim 1.

With regard to claim 3, this claim specifies that the channel is the Internet and when the digital camera is connected to the docking unit, the processor automatically causes the connection over the Internet to a predetermined service provider, and the predetermined service provider automatically provides the plurality of transferred images to the channel for transfer to the memory in the digital camera. Again, the Examiner argues that these limitations are met by the proposed combination of Safai, Viktors and Tanaka, but fails to identify any objective evidence of motivation. See the Office Action at pages 5-6, section 4. This fails to meet the standard articulated by the Federal Circuit in the above-cited In re Sang-Su Lee case.

Issue 2

Dependent claim 2 is believed allowable for at least the reasons identified above with regard to independent claim 1. Moreover, this claim is believed

to define separately-patentable subject matter relative to the proposed combination of the Safai, Viktors, Tanaka and Sato references, as indicated below.

Claim 2 specifies that the processor further receives content files via the channel and causes information from such content files to be stored in the memory and to be displayed on the viewable display, the content files corresponding to content categories previously selected. The Examiner argues that these limitations are met by the proposed combination of Safai, Viktors, Tanaka and Sato, but fails to provide any objective evidence of motivation, stating instead that the combination or modification would be obvious because it would “make the information user selectable” (Office Action, page 5, section 7). This fails to meet the standard articulated by the Federal Circuit in the above-cited In re Sang-Su Lee case.

Issue 3

Dependent claim 4 is believed allowable for at least the reasons identified above with regard to independent claim 1. Moreover, this claim is believed to define separately-patentable subject matter relative to the proposed combination of the Safai, Viktors, Tanaka and Design Rule references, as indicated below.

Claim 4 specifies that the captured digital images are stored as JPEG files in a first subdirectory and the transferred digital images are stored as JPEG files in a second subdirectory. The Examiner argues that these limitations are met by the proposed combination of the Safai, Viktors, Tanaka and Design Rule references, but fails to provide any objective evidence of motivation, stating instead that the combination or modification would be obvious because the Design Rule reference “teaches the use of storage of JPEG files in different directories” (Office Action, page 6, section 9). Again, this fails to meet the standard articulated by the Federal Circuit in the above-cited In re Sang-Su Lee case. Also, it fails to address the particular limitation of the claim, namely, storage of captured digital images as JPEG files in a first subdirectory and storage of transferred digital images as JPEG files in a second subdirectory. There is apparently no mention of this particular subdirectory structure, with distinct subdirectories for captured and transferred digital images, in the proposed combination of references.

Issue 4

Applicants submit that the Examiner has failed to establish a proper *prima facie* case of obviousness in the §103(a) rejection of claims 5-7, 9 and 10, in that the Safai and Sato references, even if assumed to be combinable, fail to teach or suggest all the claim limitations, and in that no cogent motivation has been identified for combining the references or modifying the reference teachings to reach the claimed invention.

Independent claim 5 is directed to a system including digital cameras, docking units, and a service provider. The service provider includes a memory for storing a plurality of user accounts, each identifying particular content categories previously selected by a particular user, and content information corresponding to the plurality of content categories. The service provider communicates content information to digital cameras associated with the user accounts, whereby the content information, corresponding to content categories identified in the service account associated with each digital camera, is communicated over the Internet to the digital cameras via their respective docking units.

The Examiner relies on the combined teachings of Safai and Sato. However, these references collectively fail to teach the claimed service provider memory configuration, and associated communication of content to digital cameras via associated docking units. For example, the claim, as indicated above, recites that each user account identifies particular content categories previously selected by a particular user, and content information corresponding to the plurality of content categories. The camera owner account used for the photo album service of Safai, as described at column 15, lines 28-45, does not meet this particular limitation, in that there is apparently only a single category for each camera owner. Also, there is no objective evidence of motivation to combine the references or to modify their teachings to reach the limitations in question. The Examiner instead states that the combination would be obvious because it would allow “information to be easily obtained” (Office Action, page 7, last two lines, to page 8, line 3). The Examiner appears to be reciting an advantage of the claimed arrangement as evidence of

motivation to combine references or to modify reference teachings. Again, the standard set forth in In re Sang-Su Lee has not been met.

Dependent claims 6, 7, 9 and 10 are believed allowable for at least the reasons identified above with regard to independent claim 5.

Applicants further submit that the Examiner has failed to establish a proper *prima facie* case of obviousness in the §103(a) rejection of claims 12-15, in that the Safai and Sato references, even if assumed to be combinable, fail to teach or suggest all the claim limitations, and in that no cogent motivation has been identified for combining the references or modifying the reference teachings to reach the claimed invention.

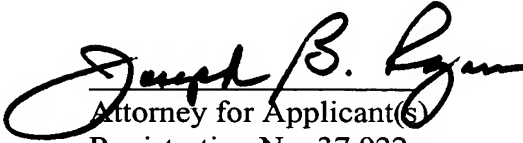
Independent claim 12 is directed to a method for providing communication over a channel between a service provider and a plurality of digital camera users, where a given digital camera has an associated docking unit. The service provider includes a memory for storing a user accounts, each identifying particular content categories previously selected by a particular user, and content information corresponding to the plurality of content categories. Content information is communicated to the plurality of digital cameras associated with the plurality of user accounts. The content information, corresponding to content categories identified in the service account associated with each digital camera, is communicated over the channel to the digital cameras. The digital cameras receive the content information and display it on a viewable display.

The Examiner again relies on the combined teachings of Safai and Sato. However, these references collectively fail to teach the claimed service provider memory configuration, and associated communication of content to digital cameras via associated docking units. Also, there is no objective evidence of motivation to combine the references or to modify their teachings to reach the limitations in question, for substantially the same reasons identified above with regard to claim 5.

Dependent claims 13-15 are believed allowable for at least the reasons identified above with regard to independent claim 12.

In view of the foregoing, Applicants believe that claims 1-7 and 9-15
are in condition for allowance.

Respectfully submitted,


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APPENDIX

1. A system including a digital camera and a docking unit to permit the digital camera to be coupled to a channel for communication with a service provider, comprising:

a) the digital camera including:

i) a viewable display;

ii) a lens for providing an optical image;

iii) an image sensor for receiving the optical image

provided by the lens to produce an image signal, a processor responsive to the image signal for producing a digital image so that the viewable display can respond to such image to provide a viewable image;

iv) a memory for storing a plurality of captured digital images having a first image size, and for storing a plurality of transferred digital images having a second image size, smaller than the first image size;

v) a docking interface to permit the digital camera to be connected to the docking unit; and a processor coupled to the memory for providing communication through the docking unit to a channel so that captured digital images stored in the memory are transferred over the channel to the service provider and transferred digital images are received over the channel from the service provider and stored in the memory, the processor further being couple to the viewable display so that the captured digital images and the transferred digital images stored in the memory can be viewed on the viewable display; and

b) the docking unit including:

i) a connector for receiving the docking interface in the digital camera and for connecting the digital camera to the docking unit;

ii) a power supply for providing power to the digital camera; and

iii) a network connection for interconnecting the docking unit to the channel for transferring captured digital images of the first size to the service provider and for receiving transferred digital images of the second size from the service provider.

2. The system of claim 1 wherein the processor further receives content files via the channel and causes information from such content files to be stored in the memory and to be displayed on the viewable display, the content files corresponding to content categories previously selected.

3. The system of claim 1 wherein the channel is the Internet and when the digital camera is connected to the docking unit, the processor automatically causes the connection over the Internet to a predetermined service provider, and the predetermined service provider automatically provides the plurality of transferred images to the channel for transfer to the memory in the digital camera.

4. The system of claim 1 wherein the captured digital images are stored as JPEG files in a first subdirectory and the transferred digital images are stored as JPEG files in a second subdirectory.

5. A system including a plurality of digital cameras, and docking units, and a service provider, to permit the digital camera to be coupled to the Internet, comprising:

- a) the digital camera including:
 - i) a viewable display;
 - ii) an image capture lens;
 - iii) an image sensor for receiving a visual image provided by the capture lens to produce an image signal, a processor responsive to the image signal for producing a digital image so that the viewable display can respond to such image to provide a viewable image;
 - iv) a docking interface to permit the digital camera to be connected to the docking unit; and
- b) the docking unit including:
 - i) a connector for providing an electrical connection with the docking interface in the digital camera; and
 - ii) a network connection for interconnecting the docking unit to the channel; and
- c) the service provider including a memory for storing a plurality of user accounts, each identifying particular content categories previously selected by a particular user, and content information corresponding to the plurality of content categories, and for communicating content information to a plurality of digital cameras associated with the plurality of user accounts, whereby the content information, corresponding to content categories identified in the service account

associated with each digital camera, is communicated over the Internet to the plurality of digital cameras; and

d) the digital camera receiving the content information and displaying the content information on the viewable display.

6. The system of claim 5 wherein the service provider also communicates digital image files over the Internet to the digital camera, and the digital camera receives and displays the digital image files on the viewable display.

7. The system of claim 5 wherein the content categories include at least one sports team selected by a particular user.

8. Canceled.

9. The system of claim 5 wherein the content categories include at least one stock selected by a particular user.

10. The system of claim 5 wherein the content category includes at least one sports category, a news category and a financial category.

11. The system of claim 1 wherein the processor reduces the size of the captured digital images prior to displaying them on the viewable display.

12. A method for providing communication over a channel between a service provider and a plurality of digital camera users, wherein digital camera has an associated docking unit, and the digital camera includes:

- i) a viewable display;
- ii) an image capture lens;
- iii) an image sensor for receiving a visual image provided by the capture lens to produce an image signal, a processor responsive to the image signal for producing a digital image so that the viewable display can respond to such image to provide a viewable image;

- iv) a docking interface to permit the digital camera to be connected to the docking unit; and

the docking unit includes:

- i) a connector for providing an electrical connection with the docking interface in the digital camera; and

- ii) a network connection for interconnecting the docking unit to the channel; and

the method including providing a memory for the service provider for storing a plurality of user accounts, each identifying particular content categories previously selected by a particular user, and content information corresponding to the plurality of content categories;

communicating content information to the plurality of digital cameras associated with the plurality of user accounts, whereby the content information, corresponding to content categories identified in the service account associated with

each digital camera, is communicated over the channel to the plurality of digital cameras; and

the plurality of digital cameras receiving the content information and displaying the content information on the viewable display.

13. The method of claim 12 wherein the content categories include sports teams.

14. The method of claim 12 wherein the content categories include financial categories.

15. The method of claim 12 wherein the content categories include sports themes.